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20999 7590 07/26/2010 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER LONEY, DONALD J	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK J. LEVINE and JOHN VANHANDEL

Appeal 2009-014757
Application 10/631,937
Technology Center 1700

Before TERRY J. OWENS, BEVERLY A. FRANKLIN, and
KAREN M. HASTINGS, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-13, 15-17, and 19-23 which are the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

I. BACKGROUND

Claim 1, the sole independent claim, is illustrative of the invention and reads as follows:

1. A fabric having a fabric caliper, said fabric having a top surface coating that encapsulates fifty percent or less of the fabric caliper and said fabric comprising one or more guides attached to machine direction edges of a wear surface of the fabric so as to encapsulate approximately fifty percent or more of the fabric caliper with guide material in a region where the guide is attached to the fabric, wherein the guides are substantially v-shaped.

The Examiner rejected the claims under 35 U.S.C. § 103(a) as follows:

a) claims 1-13, 15-17, and 19-21 as unpatentable over Tate² in view of Kiuchi³;

b) claims 22 and 23 as unpatentable over the combined prior art of Tate, Kiuchi, and Curry⁴;

c) claims 1-13, 15-17, and 19-21 as unpatentable over Reilly⁵ in view of Kiuchi; and

d) claims 22 and 23 as unpatentable over the combined prior art of Reilly, Kiuchi, and Curry.

² US Patent 5,558,926, issued Sep. 24, 1996

³ US Patent 4,559,258, issued Dec. 17, 1985

⁴ United Kingdom Patent GB 2106557A, issued Apr. 13, 1983

⁵ US Patent 4,008,801, issued Feb. 22, 1977

OPINION

Principles of Law

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). In order to establish a prima facie case of obviousness, the Examiner must show that each limitation of the claim is described or suggested by the prior art or would have been obvious based on the knowledge of those of ordinary skill in the art. *See, e.g., In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Furthermore, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (quoted with approval in *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 417-18 (2007)).

Analysis with Factual Findings

Applying the preceding legal principles with respect to obviousness to the factual findings in this record, we determine that the Examiner has not properly identified factual findings and reasoning for establishing a prima facie case of obviousness based on the applied prior art with respect to independent claim 1.

With respect to claim 1, it is undisputed that neither Tate nor Reilly explicitly teach the fabric structure as recited in claim 1 (*see generally* Ans. 4, 5; App. Br. 10-11, 16-17).

With respect to the rejection based on Tate, the Examiner’s position is that even though Tate explicitly teaches that the coating layer 7 encapsulates at least 85% of the fabric (Ans. 4), as opposed to the claimed “fifty percent or less”, it would have been obvious to adjust “the depth of the coatings as

needed to provide a superior bond to the fabric for both coatings” based on Kiuchi’s alleged disclosure of applying coatings equally to both sides of a fabric (Ans. 5).

Appellants summarized their position in the Reply Br.:

Appellants can concede that using coatings to impregnate and thereby build fabrics is known. But Kiuchi’s teaching of applying coatings, which has nothing to do with guides, simply cannot overcome the lack of reason to change the Tate’s utterly contrary percentages. Absent the teachings of the Appellants, there is absolutely no logical reason to connect the generalized teaching of applying coatings to build fabrics to the claimed encapsulation of guides.

(Reply Br. 15).

We agree with Appellants that the Examiner fails to articulate any persuasive reason why an artisan would seek to modify Tate based on Kiuchi (*see also, e.g.* App. Br. 14-16). Significantly, Tate’s minimum of 85% for the top surface coating encapsulation is 70% more (1.7 times more) than the claimed maximum limit of 50% (and concomitant maximum of 15% for the guide encapsulation is 70% less than the claimed minimum of 50%), which teaches away from the claimed ranges. *See In re Sebek*, 465 F. 2d 904, 907 (CCPA 1972) (obviousness rejection based on optimization reversed where claimed values were outside the prior art range and the prior art optimum resided within the range).

The Examiner’s alternative § 103 rejection based on Reilly and Kiuchi also relies upon the Examiner’s rationale that adjusting the depth of “both of the coatings” of Reilly is obvious in view of Kiuchi’s coatings that encapsulate/impregnate both sides of Kiuchi’s fabric (Ans. 5). We agree with Appellants that the Examiner’s rationale “does not make sense as

Reilly's guide is adhered 9 [via an adhesive] to the belt, not impregnated, and the impregnation of the fabric backing [of Reilly] is not relevant to Kiuchi's coated belt – which has no guides whatsoever.” (Reply Br. 17, 18). The Examiner's apparent attempt, in the Response to Argument section of the Brief, to read the encapsulated guide fabric 32 *per se* of Reilly on claim 1 is also unreasonable for the reasons explained by Appellants (*see*, Ans. 7, 8; Reply Br. 16, 17). Notably, the Examiner found that “another layer is located on the other side of the fabric [18]” (Ans. 5) as the “top surface coating” required in claim 1 (*id.*). Accordingly, the Examiner has determined that “the fabric” comprises both the guide fabric 32 as well as the belt fabric 18 of Reilly. The Examiner has not identified any factual findings sufficient to conclude that it would have been obvious that the encapsulation of the guide fabric 32 is 50% or more of the total fabric caliper (which must includes fabric 18 and the coating thereon, in accordance with the Examiner's position).

Under the circumstances recounted above, it is apparent that the only teaching or suggestion for modifying either Tate or Reilly in such a manner as to achieve the claimed invention is derived from Appellants' own Specification rather than the applied prior art. Therefore, we conclude that the Examiner's rejection is improperly based upon improper hindsight reasoning. *KSR*, 550 U.S. at 421 (The fact finder must be aware “of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning”; citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a “temptation to read into the prior art the teachings of the invention in issue”)). *See also*, *W.L. Gore & Assocs., Inc. v. Garlock*,

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Inc., 721 F.2d 1551, 1553 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Since the additional reference to Curry does not cure the deficiencies of the Examiner's rejection based on Tate or Reilly, we cannot sustain the rejections of dependent claims 22 and 23 for substantially the same reasons as set out above.

Accordingly, for the reasons set forth above and in the Briefs, we cannot sustain either of the Examiner's rejections of independent claim 1, and its respective dependent claims.

CONCLUSION/ORDER

The Examiner's decision to reject the appealed claims is reversed.

REVERSED

sld

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